

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Simon L. McGurk et al.

Title: GEL STABILIZED NANOPARTICULATE ACTIVE AGENT COMPOSITIONS

Appl. No.: 10/659,706

Filing Date: 9/11/2003

Patent No.: **7,713,551 B2**

Grant Date: May 11, 2010

Examiner: Eric E. Silverman

Art Unit: 1618

Confirmation Number: 4753

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR
PATENT APPLICATION UNDER 37 C.F.R. §1.705(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants have calculated PTA for the captioned patent and have determined that the patent is entitled to 578 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitutes a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 776 days

(b) Total Applicant delay: 198 days

Final PTA Determination: 578 days

Applicants believe the 150 day reduction between the filing of a Notice of Appeal on 3/20/2007 and an RCE on 8/17/2007 under 35 USC 154(b)(1)(B)(ii) is not proper. 35 USC 154(b)(1)(B)(ii) provides that the guarantee of no more than 3-year pendency does not include "any time consumed by appellate review by the Board." 37 CFR 1.702(b)(4) contains parallel language. Although 37 CFR 1.703(b)(4) appears to implement these provisions by counting the number of days "beginning on the date on which a notice of appeal to the Board . . . was filed," this rule over counts days, because the filing of a notice of appeal does not commence the time period of appellate review by the Board. To the contrary, *as set forth in 37 CFR 41.35, jurisdiction does not pass to the Board until after all briefs and the examiner's answer have been issued, at which time the Technology Center transmits the file to the Board. Until then, there is no "appellate review by the Board," and the examiner maintains jurisdiction, for example, to reopen prosecution or issue a notice of allowance.*

In this application, there was no appellate review by the Board; no Brief on Appeal was ever filed. The notice of appeal was filed to maintain pendency while the examiner considered Applicants' filed response, and an Advisory Action was issued on 1/24/2007, after which Applicants filed an RCE on 8/17/2007. Thus, the 150 day period between the filing of a Notice of Appeal on 3/20/2007 and an RCE on 8/17/2007 was in no way related to appellate review by the Board, and so 35 USC 154(b)(1)(B)(ii) does not justify excluding 150 days from the 3-year pendency calculation.

Applicants therefore respectfully request that the patent be accorded 578 days PTA.

The patent is not subject to a terminal disclaimer.

The required fee for this submission was submitted on December 28, 2009, however, the Commissioner is authorized to charge any fees that may be due for this filing or credit any overpayment to Deposit Account No. 19-0741.

Respectfully submitted,

By 

Date: June 16, 2010

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Docket Number: 029318-0968

Application Number: 10/659706

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	09/11/2003	0		
	14 month From Application date	11/11/2004	427		
Edit Delete	Restriction Requirement	01/09/2006	851	424	
Edit Delete	Restriction Requirement Response Received at PTO	01/20/2006	862		
Edit Delete	Non-Final Office Action	04/10/2006	942		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	07/07/2006	1,030		
	3 Year Period Starts	09/11/2006	1,096		
Edit Delete	Final Office Action	10/20/2006	1,135		
Edit Delete	Final Office Action Response Received at PTO	01/08/2007	1,215		
	Final Office Action + 3 months	01/20/2007	1,227		
Edit Delete	Advisory Action	01/24/2007	1,231		
Edit Delete	Notice of Appeal Received at PTO	03/20/2007	1,286		59
	3 Year Period Stopped	08/16/2007	1,435	339	
Edit Delete	Request For Continued Examination (including amendment)	08/17/2007	1,436		
Edit Delete	Non-Final Office Action	10/19/2007	1,499		
	Non-Final Office Action + 3 months	01/19/2008	1,591		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	01/22/2008	1,594		3
Edit Delete	IDS under 1.704(c)(8) filed at PTO	04/02/2008	1,665		71
Edit Delete	Final Office Action	04/16/2008	1,679		
Edit Delete	Final Office Action Response Received at PTO	07/07/2008	1,761		
	Final Office Action + 3 months	07/16/2008	1,770		
Edit Delete	Advisory Action	07/28/2008	1,782		
Edit Delete	Notice of Appeal Received at PTO	08/06/2008	1,791		
Edit Delete	Request For Continued Examination (including amendment)	10/22/2008	1,868		21
Edit Delete	Non-Final Office Action	11/19/2008	1,896		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/16/2008	1,923		

Edit Delete	Non-Final Office Action	02/24/2009	1,993	
Edit Delete	Non Final Office Action Rsp. Rcv'd at PTO	04/15/2009	2,043	
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Edit Delete	Final Office Action Response Received at PTO	06/09/2009	2,098	
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	Final Office Action + 3 months	08/01/2009	2,151	
Edit Delete	Advisory Action	08/21/2009	2,171	
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Edit Delete	Notice of Allowance	10/06/2009	2,217	
Edit Delete	Issue Fee Paid	12/28/2009	2,300	
Edit Delete	Rule 312 Amendment Received at PTO	12/28/2009	2,300	
Edit Delete	Response to Rule 312 Communication Received	01/08/2010	2,311	
	Issue Fee Paid + 4 months	04/28/2010	2,421	
Edit Delete	Patent Grant Date	05/11/2010	2,434	13
			Totals:	776
			PTA:	198
				578

